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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/992,770 12/17/97 HACHIYA

K SONY-6900

LM02/1220

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EXAMINER

VU, T

ART UNIT

PAPER NUMBER

2756

DATE MAILED:

12/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/992,770

Applicant(s)

Hachiya et al

Examiner

Thong Vu

Group Art Unit
2756



☒ Responsive to communication(s) filed on Oct 1, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) 25-32 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2756

DETAILED ACTION

Introduction

1. This office action is in response to Amendment A filed Sep 14, 1999. Amended claims 1-24 and new claims 25-32 are pending. The objections and rejections cited are as state below

Response to Amendment

2. Applicant's amendment filed Sep 14, 1999 have been fully considered but they are moot in view of the new ground(s) of rejection.

Election/Restriction

3. *Newly submitted claim 25-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the on-line shopping system is a distinctly function from the Email apparatus and require the further consideration or search.*

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-32 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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Claims 1-3 are rejected under 35 U.S.C. § 102 (b) as being unpatentable over Thorne et al [5,958,005]

As per claim 1, Thorne et al disclose *a method for automatic control the transmission of an Email* as the method for controlling of confidential email [col 1 line 8]; *a plurality of agent parameters controlling the behavior of an agent delivering an E-mail are appended to the main mail text having an appended main header* such as different agents [col 3 line 25] with security parameter [col 6 line 49] ... by the appended header , *responsive to a send command designating the transmission of the E-mail for transmission to a recipient* such as acknowledges receipt and sends it forward until it reaches the addressed terminal [col 9 lines 30-32];

the agent parameters are modified responsive to the contents of experiences reflecting the operating hysteresis for the agent such as any applicable menu box is modified [col 10 line 15]... the operating hysteresis or temporary file [col 9 line 15]; and

an E-mail of a pre-set illustrative sentence is sent by said agent to the recipient based on said agent parameters such as the message forwarding icon [col 10 line 4]. By this rationale claim 1 is rejected.

As per claim 2, Thorne et al disclose *a control procedure is performed so that an illustrative sentence of an E-mail for transmission is randomly selected from a plurality of illustrative sentences classed* [abstract, col 1 line 24, col 2 line 55], *and pre-set (or preselect dat) depending on the contents of experiences (or copy in memory) acquired by said agent so that the selected sentence are in a class consistent (or security class) with the contents of experiences acquired by said agent* [col 3 line 18, 4 line 1-4, col 7 lines 5-42, col 8 lines 1-12], *the selected*

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sentence being voluntarily sent to the recipient or the message is automatically transmitted to recipient [col 8 line 63]. By this rationale claim 2 is rejected.

As per claim 3 Thorne et al disclose *an effective period of said agent is set and an E-mail is voluntarily sent to the recipient upon expiration of said effective period*]col 10 line 52]. By this rationale claim 3 is rejected.

As per claims 4-5, 12-13,17-18,20-21 contain the similar limitations set forth of method claims 1-2. Therefore, claims 4-5, 12-13,17-18,20-21 are rejected for the same rationale set forth claims 1-2.

As per claims 6-8,9-11,14-16,17-19,22-24 contains the similar limitations set forth of method claims 1-3. Therefore, claims 6-8,9-11,14-16,17-19,22-24 are rejected for the same rationale set forth claims 1-3.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-**Ferstenberg et al**, Computer method and system for intermediated exchange of commodities [5,873,071]

-**Blakeley et al**, transaction message routing in digital communication networks [5,734,651]

-**Juster**, Call processing system and method for providing a variety of messaging services [5,724,406]

-**Hoffer**, Interactive electronic trade network and user interface [5,799,151]

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-**Matsuo**, System for automatically sending mail message by storing rule according to the language specification of the message including processing condition and processing content [5,634,005]

-**Kara**, System and method for storing, retrieving and automatically printing postage on mail [5,666,284]

-**Allum et al**, Mail encoding and processing system [5,420,403]

-**Kerbs**, Video mail delivery system [5,557,320]

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 6:30AM- 4:00PM. The examiner can also be reached on alternate Fridays during the same hours.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Frank Asta*, can be reached on (703) 305-3817 or via e-mail addressed to [*Frank.Asta@uspto.gov*]. The fax number for this Group is (703) 308-6606 or 308-9731

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [*thong.vu@uspto.gov*].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Thong Vu
703-305-4643
Dec 16, 1999


FRANK J. ASTA
SUPERVISORY PATENT EXAMINER
GROUP 2700